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PFIZER IRELAND PHARMACEUTICALS

v.

RANBAXY (MALAYSIA) SDN BHD

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COURT OF APPEAL, PUTRAJAYA
ABDUL MALIK ISHAK JCA
MOHAMED APANDI ALI JCA
BALIA YUSOF WAHI JCA
[CIVIL APPEAL NO: W-02(IM)-2580-10-2011]

C

11 JANUARY 2013

CIVIL PROCEDURE: *Amendment - Patents - Application to amend patent - Power of court to order amendment under O. 20 r. 8 Rules of the High Court 1980 - Whether restricted and confined only to court*

D

documents and pleadings - Whether Registrar of Patents will make amendment to a patent if there are, pending before any court, proceedings in which validity of patent may be put in use - Patents Act 1983, s. 79A(3) - Whether amendment would deprive plaintiff of opportunity to seek redress for invalidation of patent - Whether amendment would

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injure or prejudicially affect vested right of plaintiff

PATENTS: *Amendment - Application to amend patent - Power of court to order amendment under O. 20 r. 8 Rules of the High Court 1980 - Whether restricted and confined only to court documents and pleadings -*

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Whether Registrar of Patents will make amendment to a patent if there are, pending before any court, proceedings in which validity of patent may be put in use - Patents Act 1983, s. 79A(3) - Whether amendment would deprive plaintiff of opportunity to seek redress for invalidation of patent - Whether amendment would injure or prejudicially affect vested

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right of plaintiff

The respondent ('plaintiff') was a company related to Ranbaxy Laboratories Limited, a pharmaceutical company. The appellant ('defendant') and Pfizer (Malaysia) Sdn Bhd were related companies of Pfizer Inc, the latter known as the world's largest

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research based pharmaceutical company. Viagra, a prescription drug to treat erectile dysfunction, was an anti-impotence oral medication discovered, developed and marketed by the defendant. The defendant had invested its time and money by doing research which finally led to the discovery of sildenafil, an active ingredient

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of Viagra. Viagra was protected by several patents, one of them

being the Malaysian Patent no: MY-111446-A entitled "Pyrazolopyrimidinones for the treatment of impotence" ('446 patent') which was currently registered in the name of the defendant. The plaintiff had also launched a generic drug called Caverta which contained sildenafil citrate which had the same compound used in Viagra. To achieve its purpose to manufacture and distribute Caverta in Malaysia, the plaintiff commenced legal proceedings against the defendant under ss. 56 and 57 of the Patents Act 1983 ('Act') and sought to declare the 446 Patent as null and void in Malaysia. In its defence and counterclaim, the defendant relied upon, *inter alia*, the defendant's corresponding US Patent US6,469,012, entitled "Pyrazolopyrimidinones for the treatment of impotence" ('US Patent US6,469,012'). In a separate suit between Pfizer Inc Group of Companies ('Pfizer') and Teva Pharmaceuticals USA Inc ('Teva') for imminent infringement of Pzifer's US Patent US6,469,012, the US District Court, Eastern District of Virginia, handed down its decision and affirmed the validity of the US Patent US6,469,012 and entered judgment for Pfizer on patent infringement. As a result of the said decision of the US District Court, the defendant intended to amend the 446 Patent to conform to the US Patent US6,469,012. The defendant filed an application in the High Court *vide* encl. 11 pursuant to O. 20 r. 8 of the Rules of the High Court 1980 ('RHC') and s. 56 of the Act and/or the inherent powers of the High Court and sought for the 446 Patent to be amended. However, the High Court dismissed the said application. Hence, this appeal.

Held (dismissing appeal with costs)
Per Abdul Malik Ishak JCA delivering the judgment of the court:

(1) The powers of the court to order an amendment under O. 20 r. 8 of the RHC are restricted and confined only to court documents and pleadings. Thus, it was not open to the court to allow an amendment to a non-court document like the 446 Patent. The 446 Patent was not a court document or a pleading and accordingly, the High Court had absolutely no power pursuant to O. 20 r. 8 of the RHC to order any amendment to the 446 Patent which had been duly examined and granted by the Malaysian Intellectual Property Office. (paras 27 & 31)

(2) The court was not the forum to amend the 446 Patent bearing in mind that a patent is a creature of a specific statute, namely the Patents Act 1983, and all matters pertaining to the procedure of amending a granted patent is governed by the Act. Further, by virtue of s. 79A(3) of the Act, the Registrar of Patents shall not make any amendment to a patent if there are, pending before any court, proceedings in which the validity of the patent may be put in use. (paras 26 & 31)

(3) Such an amendment would be allowed if "it will not injure or prejudicially affect" the vested right of the plaintiff here. The defendant's application to amend the 446 Patent would certainly prejudice the plaintiff's case when the case comes up for hearing before the High Court. It would certainly deprive the plaintiff of an opportunity to seek redress for invalidation of the 446 Patent under s. 56 of the Act on the grounds of lack of novelty, lack of incentive steps and insufficiency. The proposed amendment of the 446 Patent was certainly prejudicial to the plaintiff. It had the effect of changing the entire character of the invalidation suit which was still pending before the High Court. This was the injustice which the plaintiff would incur and suffer and which could not be compensated by costs because the plaintiff's statement of claim and the particulars of objection would have to be altered dramatically as a consequence. (paras 27, 31, 49 & 50)

(4) The High Court in disallowing encl. 11 had applied correctly the law to the facts and had given cogent reasons for disallowing the application. The High Court had correctly appreciated the facts and held that the defendant's right or interest would not be prejudiced because the defendant would still have the right to refute the plaintiff's claims at the trial proper. Thus, the decision of the High Court was affirmed. (paras 46 & 51)

Bahasa Malaysia *Translation Of Headnotes*

Responden ('plaintif') adalah syarikat yang berkaitan dengan Ranbaxy Laboratories Limited, sebuah syarikat farmaseutikal. Perayu ('defendan') dan Pfizer (Malaysia) Sdn Bhd adalah syarikat-syarikat berkaitan dengan Pfizer Inc, yang dikenali sebagai syarikat berasaskan penyelidikan farmaseutikal terbesar di dunia. Viagra,

dadah preskripsi untuk merawati penyakit mati pucuk, adalah ubat oral mencegah mati pucuk yang ditemui, dibangunkan dan dipasarkan oleh defendan. Defendan telah melabur masa dan wang melakukan penyelidikan yang membawa kepada penemuan sildenafil, satu bahan aktif Viagra. Viagra dilindungi oleh beberapa paten, salah satunya adalah Paten Malaysia no; MY-111446-A bertajuk "Pyrazolopyrimidinones bagi rawatan mati pucuk" ('Paten 446') yang telah didaftarkan di dalam nama defendan. Plaintif juga telah memperkenalkan satu dadah generik yang dipanggil Caverta yang mengandungi sildenafil citrate yang mempunyai kompaun yang sama seperti Viagra. Untuk mencapai tujuan mengeluarkan dan mengedarkan Caverta di Malaysia, plaintif memulakan prosiding undang-undang terhadap defendan di bawah ss. 56 dan 57 Akta Paten 1983 ('Akta') dan berusaha untuk mengisytiharkan Paten 446 sebagai tidak sah dan terbatal di Malaysia. Dalam pembelaan dan tuntutan balasnya, defendan merujuk kepada, antara lain, Paten US defendan US6,469,012, bertajuk "Pyrazolopyrimidinones bagi rawatan mati pucuk" ('Paten US US6,469,012'). Di dalam satu guaman yang lain di antara Pfizer Inc Group of Companies ('Pfizer') dan Teva Pharmaceuticals USA Inc ('Teva') bagi pelanggaran Paten US US6,469,012. Mahkamah Daerah US, Daerah Timur Virginia, telah memberi keputusannya dan telah mengesahkan kesahihan Paten US US6,469,012 dan telah memasukkan penghakiman bagi Pfizer atas pelanggaran paten. Hasil daripada keputusan Mahkamah Daerah US tersebut, defendan berniat untuk meminda Paten 446 untuk mematuhi Paten US US6,469,012. Defendan memfailkan satu permohonan di Mahkamah Tinggi melalui lampiran 11 di bawah A. 20 k. 8 Kaedah-Kaedah Mahkamah Tinggi 1980 ('KMT') dan s. 56 Akta Paten 1983 dan/atau kuasa sedia ada Mahkamah Tinggi dan memohon pindaan Paten 446. Walaubagaimanapun, Mahkamah Tinggi telah menolak permohonan pindaan tersebut. Oleh itu, rayuan ini.

Diputuskan (menolak rayuan dengan kos)
Oleh Abdul Malik Ishak HMR menyampaikan penghakiman mahkamah:

(1) Kuasa mahkamah untuk membuat perintah pindaan di bawah A. 20 k. 8 KMT hanya terhad kepada dokumen-dokumen mahkamah dan pliding-pliding. Oleh itu, ia tidak terbuka kepada mahkamah untuk membenarkan pindaan kepada bukan

dokumen mahkamah seperti Paten 446. Paten 446 bukan dokumen mahkamah atau pliding, oleh itu Mahkamah Tinggi tidak mempunyai kuasa di bawah A. 20 k. 8 KMT untuk membuat apa-apa perintah pindaan ke atas Paten 446 yang telah diperiksa dan dibenarkan oleh Pejabat Harta Intelektual Malaysia.

(2) Mahkamah bukan forum untuk meminda Paten 446, mengambil kira paten adalah penciptaan statut khusus, iaitu Akta Paten 1983, dan semua perkara yang berkaitan dengan prosedur pindaan paten yang telah diberikan adalah ditakluk oleh Akta itu. Seterusnya, menurut s. 79A(3) Akta, Pendaftar Paten tidak akan membuat pindaan kepada paten jika, terdapat di hadapan mana-mana mahkamah, prosiding-prosiding di mana kesahihan paten mungkin digunakan.

(3) Pindaan sebegitu boleh dibenarkan jika "ia tidak menjejaskan atau memprejudiskan" kepentingan terletakhak plaintif di sini. Permohonan defendan untuk meminda Paten 446 pasti akan memprejudiskan kes plaintif apabila kes itu dibicarakan di Mahkamah Tinggi. Ia pasti akan menafikan plaintif peluang pembelaan bagi pembatalan Paten 446 di bawah s. 56 Akta atas alasan-alasan kekurangan kebaharuan, kekurangan langkah-langkah insentif dan apa-apa kekurangan lain. Pindaan yang dicadangkan pada Paten 446 pastinya memprejudiskan plaintif. Ia mempunyai kesan mengubah sifat guaman kesahihan yang masih belum selesai di hadapan Mahkamah Tinggi. Ini adalah ketidakadilan yang akan dialami oleh plaintif yang tidak mungkin boleh diberi ganti rugi dengan kos kerana penyata tuntutan dan butir-butir bantahan perlu diubah secara mendadak.

(4) Mahkamah Tinggi dalam tidak membenarkan lampiran 11 telah menggunapakai undang-undang kepada fakta-fakta dengan betul dan telah memberi sebab-sebab yang meyakinkan untuk tidak membenarkan permohonan itu. Mahkamah Tinggi telah dengan betul menilai fakta-fakta dan memutuskan bahawa hak atau kepentingan defendan tidak akan diprejudiskan sebab defendan masih mempunyai hak untuk menyangkal tuntutan plaintif semasa perbicaraan betul. Oleh itu, keputusan Mahkamah Tinggi disahkan.

Case(s) referred to:

Abdul Johari Abdul Rahman v. Lim How Chong & Ors [1997] 1 CLJ 361 CA ***(refd)***

Bagusia Sdn Bhd v. Malaysia Assurance Alliance Bhd [2005] 1 LNS 38 HC ***(dist)***

Cold Storage Holdings Plc and Others v. Overseas Assurance Corp Ltd and Another [1988] 1 SLR(R) 255 ***(dist)***

Collett v. Morrison [1851] 68 ER 458 ***(dist)***

Cotton Corporation of India Ltd v. United Industrial Bank Ltd AIR [1983] SC 1272 ***(refd)***

Dato' Seri Anwar Ibrahim v. PP [2010] 7 CLJ 397 FC ***(refd)***

Dato' Tan Heng Chew v. Tan Kim Hor & Ors [2008] 7 CLJ 776 HC ***(refd)***

Government of Malaysia v. Jasanusa Sdn Bhd [1995] 2 CLJ 701 SC ***(refd)***

Hodgkinson v. Wyatt [1864] 50 ER 462 ***(dist)***

M-Fold Development Sdn Bhd v. Altrue Sdn Bhd [2002] 2 CLJ 44 HC ***(refd)***

Mabuchi Motor KK's Patents [1996] RPC 387 ***(refd)***

Oh Hiam & Ors v. Tham Kong [1980] 1 LNS 53 PC ***(dist)***

Re CHS [2001] 8 CLJ 653 HC ***(refd)***

Shell Singapore (Pte) Ltd v. Chuan Hong Auto (Pte) Ltd [1987] SLR(R) 557 ***(dist)***

Smithson and Others v. Hamilton [2008] 1 WLR 1453 ***(dist)***

The Attorney General of HongKong v. Zauyah Wan Chik & 3 Ors & Another Appeal [1995] 3 CLJ 35 CA ***(refd)***

Wright v. Goff [1856] 52 ER 1087 ***(dist)***

Yamaha Motor Co Ltd v. Yamaha (M) Sdn Bhd & Ors [1983] 1 CLJ 191; [1983] CLJ (Rep) 428 FC ***(refd)***

Legislation referred to:

Patents Act 1983, ss. 11, 12(1), 23, 26A, 29(2), 33C, 56(2), 57, 79A(3)

Patents Regulations 1986, r. 12

Rules of the High Court 1980, O. 20 r. 8

Other source(s) referred to:

Lesley Brown, *"The New Shorter Oxford English Dictionary On Historical Principles"*, vol 2, p. 2121

P Narayanan, "*Patent Law*", 4th edn, p. 1

For the plaintiff/respondent - Joshua Kevin Sathiaseelan (Azura Adnan & Tan Eng Guat with him); M/s Miranda & Samuel

For the defendant/appellant - Jack Yow Pit Pin (Pauline Khor Hong Ping with him); M/s Rahmat Lim & Partners

[Appeal from High Court Malaya, Kuala Lumpur; Civil Suit No: D-22(IP)-21-2010]

Reported by Suhainah Wahiduddin

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JUDGMENT

Abdul Malik Ishak JCA:

Background Facts

B **[1]** For convenience, the parties will be referred to like what they were referred to at the High Court. Thus, Ranbaxy (Malaysia) Sdn Bhd will be referred to as the "plaintiff", while Pfizer Ireland Pharmaceuticals will be referred to as the "defendant".

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[2] The plaintiff is a stiff competitor of the defendant. The plaintiff is related to Ranbaxy Laboratories Limited, a pharmaceutical company with its headquarters in India. While the defendant and Pfizer (Malaysia) Sdn Bhd are related companies of
D Pfizer Inc, and the latter is the world's largest research based pharmaceutical company.

[3] VIAGRA is a prescription drug to treat erectile dysfunction. It is an anti-impotence oral medication discovered, developed and
E marketed by the defendant. The defendant invested time and money doing research which finally led to the discovery of sildenafil - an active ingredient of VIAGRA. In 1998, VIAGRA was launched and it is made available to Malaysian erectile dysfunction patients.

F **[4]** Now, in Malaysia, VIAGRA is protected by several patents. Notable among them is the Malaysian Patent No: MY-111446-A entitled "Pyrazolopyrimidinones for the treatment of impotence" (hereinafter referred to as the "446 Patent"). Currently, the 446 Patent is registered in the name of the defendant and it is valid
G and subsisting until 31 May 2015. The 446 Patent concerns the use of sildenafil for the treatment of erectile dysfunction.

[5] Not to be outwitted, the plaintiff also launched a generic drug called CAVERTA which contains sildenafil citrate - the same
H compound that is used in VIAGRA. The plaintiff proposes to manufacture and distribute CAVERTA in Malaysia. To achieve its purpose, the plaintiff has commenced this lawsuit before the High Court to invalidate the 446 Patent so that it could commercialise and sell CAVERTA to the Malaysian public.

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[6] By way of a writ dated 19 March 2010 and a statement of claim dated 18 March 2010, the plaintiff commenced legal proceedings against the defendant under ss. 56 and 57 of the Patents Act 1983 and sought to declare the 446 Patent as null and void in Malaysia. In its statement of claim, the plaintiff heavily relied on the fate of the defendant's corresponding European Patent EP 0702555 B2 entitled "Pyrazolopyrimidinones for the treatment of impotence" which was revoked by the Boards of Appeal of the European Patent Office on 11 October 2001 *vide* a decision handed down on 3 February 2005.

[7] In its defence and counterclaim dated 30 June 2010, the defendant relied upon, *inter alia*, the defendant's corresponding US Patent US6,469,012 entitled "Pyrazolopyrimidinones for the treatment of impotence". At the time when the defence and counterclaim was filed, US Patent US6,469,012 had already been re-examined by the USPTO resulting in claims 1-23 and 25-26 being upheld (see p. 842 of the appeal record at Jilid 5, Bahagian "B" at para. 12 of the defendant's affidavit and exhibit marked as "AMM3").

[8] The plaintiff filed its reply to defence and defence to counterclaim dated 14 September 2010. We do not propose to delve into it. The trial before the High Court has not started and it is better for the High Court to consider the pleadings and the evidence led at the trial proper.

[9] Now, on 24 March 2010, the Pfizer Inc group of companies ("Pfizer") sued Teva Pharmaceuticals USA Inc ("Teva") for imminent infringement of its US Patent US6,469,012. Teva, in retaliation, filed a counterclaim against Pfizer seeking a declaration that Teva's planned drug which is a generic equivalent of VIAGRA and containing the active ingredient sildenafil citrate will not infringe US Patent US6,469,012 and that the claims of US Patent US6,469,012 are invalid. One of the grounds of invalidity relied upon by Teva is that the claims of US Patent US6,469,012 are obvious in light of the prior art. The same argument is adopted by the plaintiff in this lawsuit. And the same prior art documents that have been relied upon by Teva have also been relied upon by the plaintiff in this lawsuit.

[10] The US District Court, Eastern District of Virginia handed down its decision on 12 August 2011 and affirmed the validity of the US Patent US6,469,012 and found the claims of the said patent to be non-obvious. The US District Court, Eastern District of Virginia also found that Teva had not shown by clear and convincing evidence that the claims 25-26 of US Patent US6,469,012 were invalid because of obviousness and the court entered judgment for Pfizer on patent infringement.

[11] It was as a result of the decision of the US District Court, Eastern District of Virginia that prompted the defendant to file a summons-in-chambers in the High Court in encl. 11 dated 8 September 2011 pursuant to O. 20 r. 8 of the Rules of the High Court 1980 ("RHC") and s. 56 of the Patents Act 1983 and/or the inherent powers of the High Court and sought for the following orders:

(a) that the 446 Patent be amended to only one (1) claim, namely:

> The use of 5-[2-ethoxy-5-(4-methyl-1-piperazinylsol-phonyl) phenyl J-1-methyl-3-n-propyl-1, 6-dihydro-7H-pyrazolo [4-3-d] pyrimidin-7-one or a pharmaceutically acceptable salt thereof, or a pharmaceutical composition containing either entity, for the manufacture of a medicament for the curative or prophylactic treatment of erectile dysfunction in a male animal, including man wherein the medicament is adopted for oral treatment.

(b) that the costs of this application be made costs in the cause; and

(c) any further orders or other reliefs that this Court thinks fit and just.

[12] The High Court heard encl. 11 and dismissed it with costs. Aggrieved, the defendant appeals to this court.

Analysis

[13] The plaintiff opposed the defendant's application to amend the defendant's 446 Patent. The plaintiff has filed an invalidity suit against the defendant on 19 March 2010 contending that the 446 Patent is invalid on the grounds of lack of novelty, lack of inventive steps, added subject matter and insufficiency.

[14] In their defence, the defendant denied the plaintiff's claims and counterclaimed that the plaintiff's intention to manufacture and distribute "CAVERTA" has infringed the defendant's 446 Patent.

[15] Before the High Court and also before us, learned counsel for the defendant argued along the following lines:

(a) that the US District Court, Eastern District of Virginia affirmed the validity of the US Patent US6,469,012;

(b) as a result of the US District Court's decision, the defendant intends to amend the 446 Patent to conform to the US Patent US6,469,012;

(c) that the proposed amendments to the 446 Patent will limit and restrict the scope of the patent;

(d) that the proposed amendments would not have the effect of disclosing a matter which extends beyond that disclosed before the amendments; and

(e) that the proposed amendments would narrow down the issues to be tried and shorten the duration of the trial before the High Court.

[16] In the course of hearing the appeal, I interceded and remarked that s. 56 of the Patents Act 1983 concerned the invalidation of a patent and that the trial before the High Court centred on invalidating the 446 Patent. And that the case of *Mabuchi Motor KK's Patents* [1996] RPC 387 was not in regard to an amendment of the pleadings but rather it concerned a petition for revocation of two patents relating to brush arms for the commutators of electric motors and that case, in the context of encl. 11, was certainly irrelevant.

[17] It is quite obvious that the defendant's application in encl. 11 is an exercise in pre-empting the hearing of the invalidation before the High Court.

[18] Order 20 r. 8 of the RHC states as follows:

8. Amendment of certain other documents (O. 20 r. 8)

(1) For the purpose of determining the real question in controversy between the parties to any proceedings, or of correcting any defect or error in any proceedings, the Court

A may at any stage of the proceedings and either of its own motion or on the application of any party to the proceedings order any document in the proceedings to be amended on such terms as to costs or otherwise as may be just and in such manner (if any) as it may direct.

B (2) This rule shall not have effect in relation to a judgment or order.

[19] The "document in the proceedings to be amended" as sought by the defendant's application in encl. 11 was in regard to C the 446 Patent that has been registered in the defendant's name and its validity extends until 31 May 2015. It is this 446 Patent that the plaintiff is challenging and is seeking to invalidate at the full hearing before the High Court. Indeed my learned brother Balia Yusof bin Hj Wahi, JCA rightly remarked that encl. 11 was D in the nature of pre-empting the hearing before the High Court. The 446 Patent as presently worded in its original text should be before the High Court when the invalidation hearing is being heard.

[20] P Narayanan in his book entitled "*Patent Law*", 4th edn. at E p. 1 described a "patent" lucidly in these fine words:

> What is a Patent? A patent is an exclusive right granted to a person who has invented a new and useful article or an improvement of an existing article or a new process of making F an article. The exclusive right is to manufacture the new article invented or manufacture an article according to the invented process for a limited period. During the term of the patent the owner of the patent, ie, the patentee can prevent any other person from using the patented invention. After the expiry of the duration of the patent anybody can make use of the invention. The G invention then becomes part of the public domain.
>
> A patent is a form of industrial property, or as it is now called, an intellectual property. The owner can sell the whole or part of this property. He can also grant licences to others to use or H exploit it.
>
> A patent is a creation of statute and is therefore territorial in extent. Thus a patent granted in one country cannot be enforced in another country unless the invention concerned is patented in that country also.

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[21] *The New Shorter Oxford English Dictionary On Historical Principles* edited by Lesley Brown, vol. 2, at p. 2121 defined a "patent" as:

> A document constituting letters patent; especially a licence from a government to an individual or organisation conferring for a set period the sole right to make, use, or sell some process or invention; a right conferred in this way.

[22] Statute wise, there is s. 11 of the Patents Act 1983. It defines a patentable inventions in this way:

> 11. An invention is patentable if it is new, involves an inventive step and is industrially applicable.

[23] While s. 12(1) of the Patents Act 1983 defines an invention as "an idea of an inventor which permits in practice the solution to a specific problem in the field of technology".

[24] The hearing scheduled before the High Court revolved on the invalidation of the 446 Patent. In this context, it is ideal that ss. 23 and 56(2) of the Patents Act 1983 be read together with regulation 12 of the Patents Regulations 1986. What regulation 12 states is quite simple. It is that claims should be clear and concise and fully supported by the description and that the number of claims shall be reasonable, taking into account the nature of the invention.

[25] The procedure for the grant of patent, enforcement of patent rights and matters connected thereto are all governed by the Patents Act 1983 and the Patents Regulations 1986. Under the Patents Act 1983, the Director-General of the Intellectual Property Corporation of Malaysia is the Registrar of Patents and his function includes ensuring that the provisions of the Act are administered, enforced, given effect to, carried out and complied with.

[26] It is trite that by virtue of s. 79A(3) of the Patents Act 1983, the Registrar of Patents shall not make any amendment to a patent if there are, pending before any court, proceedings in which the validity of the patent may be put in issue. Yet, the defendant who is well aware of the express provision in s. 79A(3) of the Patents Act 1983 had on 8 September 2011, about a month before the trial commenced before the High Court, sought to amend the 446 Patent pursuant to O. 20 r. 8 of the RHC,

which in effect sought to amend all the thirteen (13) claims in the 446 Patent, leaving only one (1) claim in the proposed amended form as set out in encl. 11 which was reproduced in the early part of this judgment.

[27] The powers of the court to order amendment under O. 20 r. 8 of the RHC are restricted and confined only to court documents and pleadings. And such an amendment would be allowed if it "will not injure or prejudicially affect" the vested right of the plaintiff here. In this context, Augustine Paul JC (later FCJ) had this to say in *Re CHS* [2001] 8 CLJ 653 at p. 663; [1997] 3 MLJ 152, at pp. 162 to 163 of the report:

> The overriding principle with regard to amendments is that contained in O. 20 r. 8 which provides that, generally speaking all amendments will be allowed at any stage of the proceedings and of any document in the proceedings (other than a judgment or order) on such terms as to costs or otherwise as the court thinks just. An amendment would be refused if it would result in prejudice or injury which cannot be properly compensated for by costs. As the Supreme Court Practice (1967) states at page 291:
>
> > Accordingly, as a general rule, either party is allowed to make any amendment in his pleadings or other proceedings which is reasonably necessary for the due presentation of his case on payment of the costs of and occasioned by the amendment, provided there has been no undue delay on his part, and provided also the amendment will not injure or prejudicially affect any vested rights of his opponent.
>
> As the documents in this application did not require service on any other person thereby not resulting in prejudice to anyone and bearing in mind the urgent nature of the application and the fact that the amendment sought can be conveniently inserted in the original summons, I allowed the oral applications to amend the prayer to enable the court to give the required consent.

[28] I also had occasion to say something about O. 20 r. 8 of the RHC in the case of *Dato' Tan Heng Chew v. Tan Kim Hor & Ors* [2008] 7 CLJ 776, at p. 781, in these words:

> (5) Both rr. 5 and 8 of O. 20 of the RHC should be read together and when so read they confer upon the court a general power to allow or order amendments to be made.

[29] Continuing further in the same case, at p. 790, I had this to say:

> (16) But, not all amendments are allowed by the court. The court will refuse leave to allow an amendment if it results in prejudice or injury to the other party which cannot be properly compensated for by costs. The court too will have regard, in considering any amendment, as to any undue delay or whether the application is made *mala fide* or whether such an amendment will in any way unfairly prejudice the other party.

[30] On amendment generally, I had occasion to say in *M-Fold Development Sdn Bhd v. Altrue Sdn Bhd* [2002] 2 CLJ 44, at p. 51:

> Of significance would be the judgment of *Ketteman and Others v. Hansel Properties Ltd* [1988] 1 All ER 38, where at page 62 of the report his Lordship had this to say:
>
> > Whether an amendment should be granted is a matter for the discretion of the trial judge and he should be guided in the exercise of the discretion by his assessment of where justice lies. Many and diverse factors will bear on the exercise of this discretion. I do not think it possible to enumerate them all or wise to attempt to do so. But justice cannot always be measured in terms of money and in my view a judge is entitled to weigh in the balance the strain the litigation imposes on litigants, particularly if they are personal litigants rather than business corporations, the anxieties occasioned by facing new issues, the raising of false hopes, and the legitimate expectation that the trial will determine the issues one way or the other. Furthermore, to allow an amendment before a trial begins is quite different from allowing it at the end of the trial to give an apparently unsuccessful defendant an opportunity to renew the fight on an entirely different defence.

[31] Implicit in the above cases is the principle that it is not open to the court to allow an amendment to a non-court document like the 446 Patent. In our judgment, the 446 Patent is not a court document or a pleading and accordingly, the High Court has absolutely no power pursuant to O. 20 r. 8 of the RHC to order any amendment to the 446 Patent which has been duly examined and granted by the Malaysian Intellectual Property Office. The court is not the forum to amend the 446 Patent bearing in mind that a patent is a creature of a specific statute, namely the Patents Act 1983, and all matters pertaining to the procedure of amending a granted patent is governed by the Patents Act 1983.

[32] Zulkefli Makinudin FCJ (now Chief Judge Malaya) in *Dato' Seri Anwar Ibrahim v. PP* [2010] 7 CLJ 397, at p. 442, applied and referred to the case of *Cotton Corporation of India Ltd v. United Industrial Bank Ltd* AIR [1983] SC 1272, where Desai J (at p. 1281) said:

> And it must be remembered that inherent power of the court cannot be invoked to nullify or stultify a statutory provision.

[33] Next, it was argued by learned counsel for the defendant that there are a variety of documents which are not "court documents" but which the court had ordered amendment under its equitable jurisdiction. Such amendments, according to learned counsel for the defendant, are commonly referred to as "rectification of documents" which is a remedy that has been granted by the courts of equity for many centuries. Learned counsel for the defendant further submitted that rectification is, like other equitable remedies, discretionary and commonly sought in many classes of documents. A string of authorities were cited by learned counsel for the defendant to augment his submissions, namely:

(a) *Oh Hiam & Ors v. Tham Kong* [1980] 1 LNS 53; [1980] 2 MLJ 159, PC (concerning a sale and purchase agreement);

(b) *Cold Storage Holdings Plc and Others v. Overseas Assurance Corp Ltd and Another* [1988] 1 SLR(R) 255 (concerning an insurance agreement);

(c) *Shell Singapore (Pte) Ltd v. Chuan Hong Auto (Pte) Ltd* [1987] SLR(R) 557 (concerning lease agreement);

(d) *Wright v. Goff* [1856] 52 ER 1087 (concerning a deed poll);

(e) *Smithson and Others v. Hamilton* [2008] 1 WLR 1453 (concerning a pension fund deed);

(f) *Hodgkinson v. Wyatt* [1864] 50 ER 462 (concerning a bond);

(g) *Collett v. Morrison* [1851] 68 ER 458 (concerning a life insurance policy); and

(h) *Bagusia Sdn Bhd v. Malaysia Assurance Alliance Bhd* [2005] 1 LNS 38; [2005] 2 MLJ 605 (concerning a cover note).

[34] On the facts, these cases are distinguishable. It will now be demonstrated. *Oh Hiam & Ors v. Tham Kong* (*supra*) concerned a written agreement which was entered into between the vendor and the purchaser for the purchase of seven plots of land. From the evidence, the vendor had only intended to sell six plots of rubber land which was located at Gombak and not the land erected with a house thereon which was located at Setapak (Lot 3660). The Privy Council found that there were sufficient and convincing cogent evidence of common mistake between the parties which enable the court to order rectification of the transfer of Lot 3660.

[35] The Singapore High Court in *Cold Storage Holdings Plc and Others v. The Overseas Assurance Corp Ltd and Another* (*supra*) found that the plaintiffs have no knowledge of the existence of condition three of the insurance policy before the invocation by the defendant. Consequently, the court ordered a rectification of the insurance policy.

[36] In *Wright v. Goff* (*supra*), the English Court found that the intention of the deceased during execution of the 1846 deed was for the purpose of selling only one of her property and that she has no intention to affect or revoke the operation of the 1838 deed. The 1846 deed was thus reformed by the English Court "for the purpose of preventing its operating upon so much of the deed of 1838".

[37] The English Court in *Smithson and Others v. Hamilton* (*supra*) held that if the trustees had failed to take into account considerations which they ought to have taken into account, then the appropriate remedy would be to make an order for rectification by modifying the wording of the pension scheme.

[38] The English Court in *Hodgkinson v. Wyatt* (*supra*) ordered for reformation of the bond on the ground that the reservation of interest clause in the bond has been inserted by accident and was a mistake, which was not according to the agreement of the parties.

[39] In *Collett v. Morrison* (*supra*), the English Court held that if upon a proposal and agreement for a life insurance, a policy is drawn up by the insurance office in a form which differs from the terms of the agreement and which varies the rights of the parties assured, then the court will interfere and deal with the case based on the agreement and not on the policy.

[40] In *Bagusia Sdn Bhd v. Malaysia Assurance Alliance Bhd* (*supra*), the Kuala Lumpur High Court found that both parties had the same common intention and that is to insure the piling barge purchased by the plaintiff. The court allowed the rectification sought for by the plaintiff because it was a minor rectification which involved the amendment of the particulars and description of the piling barge in the cover note CN 541.

[41] All the cases cited by the defendant and alluded to above illustrate one common denominator. It is that the court will examine the facts of each case in order to decipher the true and common intention of the parties when making a contract, a deed, a bond or even an insurance policy and whether those facts would justify rectification of the written instrument by the court. And if the true intention of the parties have not been reduced into writing in the correct and precise manner, then the court would be inclined to interfere and rectify the wrong.

[42] The law may be stated as follows. That once a patent has been granted, it can be amended with leave either on a formal application to the Registrar of Patents or in proceedings before the court where the validity of the patent is challenged. If any amendment is allowed, it is always subject to certain statutory restrictions: that under ss. 26A and 29(2) of the Patents Act 1983, no amendment of an application for a patent may be allowed if the outcome is to disclose a matter which extended beyond the disclosure in the initial application. Upon a request by an applicant, the Registrar of Patents may correct a clerical error or an obvious mistake. Any aggrieved person has the right to apply to the court to rectify the register (see s. 33C of the Patents Act 1983).

[43] Here, the High Court rightly appraised the facts and the law and arrived at a correct decision. At p. 46 of the appeal record at Jilid 1, Bahagian "A", the High Court concluded:

> 38. Based on the facts and circumstances of this case and on the above reasons, I am exercising my discretion not to allow the defendant's application to amend the 446 Patent. The validity of the 446 Patent will be determined by the court pursuant to section 56 of the Act. Thus, enclosure 11 is dismissed with costs.

[44] This appeal concerned the exercise of discretion by the High Court when disallowing the amendment sought by the defendant in encl. 11. The appellate court will only interfere with the exercise

of that discretion if it can be shown that the discretion was wrongly exercised by the High Court. Edgar Joseph Jr FCJ (as he then was) had this to say about appellate intervention in *Government of Malaysia v. Jasanusa Sdn Bhd* [1995] 2 CLJ 701 at p. 712; [1995] 2 MLJ 105, SC, at p. 117:

> It is well settled law that the exercise of such a discretion will be interfered with by an appellate court only in exceptional circumstances; for example, where it has been demonstrated that the decision of the judge below is shown to have depended on an erroneous basis of law or fact or where no reasonable explanation is open save that the decision depended on an erroneous basis of law or fact. More particularly, the fact that we, as an appellate court, might have exercised the discretion differently is beside the point and will not therefore constitute a sufficient ground for overturning the judge's decision to grant the limited stay.

[45] Writing a separate judgment for this court in *The Attorney General of Hong Kong v. Zauyah Wan Chik & 3 Ors & Another Appeal* [1995] 3 CLJ 35; [1995] 2 MLJ 620, CA, Gopal Sri Ram JCA had this to say about appellate intervention at pp. 50 to 51 [CLJ]; pp. 637 to 638 [MLJ] of the report:

> The next point that falls to be considered is whether discretion ought to be exercised in favour of the appellants. Before dealing with this aspect of the case, it is necessary to state the principles on which this court will interfere with a decision of the High Court arrived at in the exercise of a discretion vested in it. In an appeal such as the present, where relief is granted or withheld in the exercise of discretion, the initial function of the Court of Appeal is one of review only. It is only after an appellant has demonstrated to a conviction that the High Court erred in principle or that it took into account irrelevant considerations or failed to take into account relevant considerations or that the decision has occasioned a miscarriage of justice that this court becomes seized of an original discretion of its own.

[46] Here, the High Court in disallowing the amendment application in encl. 11, had applied correctly the law to the facts and gave cogent reasons for disallowing the application. The High Court held that such an amendment, if allowed, would deprive the plaintiff of his right and opportunity, to seek redress in its invalidation of the 446 Patent hearing under s. 56 of the Patents Act 1983. The High Court also held that the proposed amendment to the 446 Patent will change the character of the suit and cause injustice to the plaintiff which cannot be compensated with costs. The High Court had correctly

appreciated the facts and held that the defendant's right or interest will not be prejudiced because the defendant will still have the right to refute the plaintiff's claims at the trial proper.

[47] It is germane, at this juncture, to refer to the case of *Yamaha Motor Co Ltd v. Yamaha (M) Sdn Bhd & Ors* [1983] 1 CLJ 191; [1983] CLJ (Rep) 428, a decision of the Federal Court. There, Mohd Azmi FJ writing for the Federal Court had this to say at pp. 429 to 430 of the report:

> Under Order 20 of the Rules of the High Court 1980, which is equivalent to Order 28 Rules of Supreme Court, a Judge has a discretion to allow leave to amend pleadings. Like any other discretion, it must of course be exercised judicially (see *Kam Hoy Trading v. Kam Fatt Tin Mine* [1963] MLJ 248). The general principle is that the Court will allow such amendments as will cause no injustice to the other parties. Three basic questions should be considered to determine whether injustice would or would not result, (1) whether the application is *bona fide*; (2) whether prejudice caused to the other side can be compensated by costs and (3) whether the amendments would not in effect turn the suit from one character into a suit of another and inconsistent character. (See *Mallal's Supreme Court Practice* page 342).

[48] Echoing the same sentiments, Abdul Malek Ahmad, JCA (later the President of the Court of Appeal) in *Abdul Johari Abdul Rahman v. Lim How Chong & Ors* [1997] 1 CLJ 361, writing for this court, after examining some authorities, had this to say at p. 371 of the report:

> In *Palaniappan a/l Kotayan v. Universiti Pertanian Malaysia* [1995] 1 CLJ 693; [1995] 1 MLJ 353, where the defendant had objected to the plaintiff applying for the fourth time to amend his statement of claim, the High Court ruled:
>
> > The Courts have a wide discretion whether or not to allow an amendment. The proper test to apply is not whether the amendment would cause injustice to the other party, but whether in the circumstances of the case, it was just to grant leave. In exercising its discretion, the Courts have to balance the prejudice involved to both the parties in allowing or disallowing the amendment. Generally, the Courts readily grant leave to amend before trial, so long as the application is made in good faith and within a reasonable time and so long as the injustice caused to the opponent can be compensated by costs.

[49] Assessing the present appeal against the backdrop of these notable authorities by eminent judges, the defendant's application to amend the 446 Patent would certainly prejudice the plaintiff's case when the case comes up for hearing before the High Court. It would certainly deprive the plaintiff of an opportunity to seek redress for invalidation of the 446 Patent under s. 56 of the Patents Act 1983 on the grounds of lack of novelty, lack of inventive steps and insufficiency. It must be borne in mind that insufficient disclosure is a ground for the invalidation of patents.

[50] The proposed amendment of the 446 Patent in encl. 11 is certainly prejudicial to the plaintiff. It has the effect of changing the entire character of the invalidation suit which is still pending before the High Court. In such a dire situation, no amount of costs would be able to compensate the plaintiff. This is the injustice which the plaintiff will incur and suffer and which cannot be compensated by costs because the plaintiff's statement of claim and the particulars of objection would have to be altered dramatically as a consequence.

[51] This is our unanimous decision. We dismissed the appeal of the defendant with costs of RM10,000. We affirmed the decision of the High Court. Deposit to the plaintiff. We also made an ancillary order that the trial before the High Court to be expedited.

[52] This judgment received the concurrence of my learned brothers Mohamed Apandi bin Hj Ali, JCA and Balia Yusof bin Hj Wahi, JCA and their Lordships agreed that this judgment be the judgment of this court.